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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 02/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,140

Applicant(s)

AHO, OUTI

Examiner

Thong H Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1-52 are pending.
2. The IDS #3, filed on 11/06/00 is missing the Form PTO-1449. Correction is required.

***Claim Rejections - 35 USC § 112***

3. Claims 16,34,52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (i.e.: a Uaprof information transmission message).

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-52 are rejected under the judicially created doctrine of double patenting over claims 1-9 of U. S. Patent No. 6,501,741 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

**Patent '741:**

(Claim 1) A method for supporting the quality of service in packet data transmission between a wireless communication device communicating with a radio network, and an information network, where data transmission between the wireless communication device and the radio network is controlled with at least one access point controller, and in which method information is transmitted between the wireless communication device and the access point controller in radio flows, wherein at least one radio flow is provided with a defined radio flow identification and a quality of service, and the quality of service is determined in a centralised manner.

(Claim 2) characterised in that the quality of service is determined by the access point controller.

(Claim 3) characterized in that for determining the quality of service, the content of the packets, preferably the content of the header of the packets, is used.

(Claim 4) characterised in that the data transmission is divided at least into a network layer and a data link layer, wherein in the method, the data transmission is conducted in packets of the network layer, which are converted into packets of the data link layer to be transmitted in a radio flow, and that the quality of service is determined on the basis of the contents of the packets of the network layer.

(Claim 5) characterised in that the packets of the radio flow are formed from packets complying with the Internet protocol.

**Application:**

(Claim 1) A method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server, the method comprising the steps of:

- Receiving and storing a multimedia message addressed to the wireless terminal at the server, said multimedia message comprising at least one multimedia component,
- Storing information on at least one property of the wireless terminal in the server, characterized in that the method further comprises determining if there is any component of the multimedia message (i.e.: radio flow) which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal (i.e.: flow identification), wherein if there exists one or more such component(s), they are selected for transmission and transmitted to the wireless terminal (i.e.: quality of service).

(Claim 2) characterized in that the method further comprises the step of selecting at least one bearer for transmission of the selected component(s) of the multimedia message (i.e.: access control point).

(Claim 3) characterized in that the selection of at least one bearer is performed in the wireless terminal (i.e.: radio network)

(Claim 4) characterized in that the method further comprises the step of transmitting a notification message (i.e.: packet header) to the wireless terminal comprising information about at least one property of said at least one multimedia component.

(Claim 6) characterized in that information on at least one property of the wireless terminal is changed to prevent or allow the transmission of at least one component of the multimedia message (i.e.: the data transmission is conducted in packets of the network layer, which are converted into packets of the data link layer to

be transmitted in a radio flow; or the packets of the radio flow are formed from packets complying with the Internet protocol).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-52 are rejected under 35 U.S.C. § 103 as being unpatentable over Burgaleta Salinas et al [Salinas, 6,469,998 B1] in view of Forslow [6,608,832 B2]

5. As per claim 1, Salinas discloses a method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server [Salinas, radio network, packet switched service, Internet, multimedia, col 1 lines 54-67], the method comprising the steps of:

- Receiving and storing a multimedia message addressed to the wireless terminal at the server [Salinas, gateway server, DNS server with databases, col 8 lines 11-40;

col 10 lines 1-26], said multimedia message comprising at least one multimedia component, said multimedia message comprising at least one multimedia component [Salinas, multimedia services, col 1 lines 54-67. It was obvious that a multimedia message includes video, audio, text, protocol, source and destination address as its components].

However Salinas does not detail

- Storing information on at least one property of the wireless terminal (i.e.: name, identifier, address, protocol) in the server, characterized in that the method further comprises determining if there is any component of the multimedia message (i.e.: monitoring the data/packet/ message) which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal (i.e.: compare data), wherein if there exists one or more such component(s), they are selected for transmission and transmitted to the wireless terminal.

It was well-known in the art that a message/packet flows through a node via Internet-wireless environment the appropriated data will be compared to the stored information of the mobile node and process (i.e.: authenticated, transmit and receive)[see Haeggstrom, col 7 lines 27-46][Forslow, col 24 lines 34-42][Jokimies, monitoring at least one parameter indicative of a property of radio signal, col 8 lines 4-32]. Examiner also found the WAP has become a standard for wireless device using on both multimedia and telephone services [see Zarom reference, col 1 lines 25-35].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of comparing the

application flow to find a matched data as a characterized component which can be handled by the mobile node as taught by Forslow into the Salinas apparatus in order to utilize the corresponding status indicator. Doing so would provide a certain particular communications service with a requested quality based on the stored information on the requested node.

6. Claims 19,35,43 contain the similar limitations set forth of apparatus claim 1. Therefore, claims 19,35,43 are rejected for the similar rationale set forth in claim 1.

7. As per claims 2,20,44 Salinas-Forslow disclose selecting at least one bearer for transmission of the selected component(s) of the multimedia message [Forslow, col 6 lines 1-15].

8. As per claims 3,21 Salinas-Forslow disclose the selection of at least one bearer is performed in the wireless terminal [Forslow, col 6 lines 1-15]

9. As per claims 4,22,36,45 Salinas-Forslow disclose transmitting a notification message to the wireless terminal comprising information about at least one property of said at least one multimedia component [Salinas, notification request/response, col 10 lines 38-54; Forslow, col 17 lines 45-60].



10. As per claims 6,24,37,46 Salinas-Forslow disclose information on at least one property of the wireless terminal is changed to prevent or allow the transmission of at least one component of the multimedia message [Forslow, filter out the station did not have the correct address, col 19 lines 45-64].

11. As per claims 7,25,47 Salinas-Forslow disclose said information on the properties of the wireless terminal comprises information on the *available storage capacity* of the wireless terminal [Salinas, status indicator of available, col 8 lines 41-56; Forslow, resource available in the mobile network, col 21 lines 45-49]

12. As per claims 8,26,48 Salinas-Forslow disclose said information on the properties of the wireless terminal comprises information on the capability of the wireless terminal to process multimedia components of a particular type [Salinas, status indicator of available, col 8 lines 41-56; Forslow, resource available in the mobile network, col 21 lines 45-49].

13. As per claims 9,27,49 Salinas-Forslow disclose the capability of the wireless terminal to process multimedia components is defined on the basis of the hardware properties of the wireless terminal and/or the properties of the *programs installed* in the wireless terminal [Forslow, col 22 lines 11-18;41-56;col 26 lines 40-46].

14. As per claims 10,28,38 Salinas-Forslow disclose a maximum time of validity is defined for the information on the properties of the wireless terminal stored in said server [Forslow, maximum delay, col 5 lines 1-10; Time-to-Live, col 13 lines 28-49].

15. As per claims 11,50 Salinas-Forslow disclose a multimedia message addressed to the wireless terminal and comprising at least one multimedia component, is received at the server and a *notification message* is transmitted to the wireless terminal to indicate that a multimedia message has arrived, characterized in that in the method it is examined (i.e.: compare) whether information on the properties of the wireless terminal in question is stored in the server, wherein, if said information is not stored in the server, said notification message is supplemented with a request to *update the properties* of the wireless terminal, wherein information on the properties of the wireless terminal is transmitted from the wireless terminal to the server [Salinas, compared packet routing, col 1 lines 32-53; update mobile subscriber information, col 3 lines 13-28].

16. As per claim 12, Salinas-Forslow disclose examined whether said information on the properties of the wireless terminal stored in the server is valid, wherein if said information is not valid, said *notification message* is supplemented with a request to update the properties of the wireless terminal [Salinas, notification request/response, col 10 lines 38-54; Forslow, col 17 lines 45-60].

17. As per claims 13,31 Salinas-Forslow disclose said property information stored in the server is used as the property information of the wireless terminal if the sever does not receive a reply from the wireless terminal to said property update request.

18. As per claims 14,29,32 Salinas-Forslow disclose a connection set-up request message is transmitted from the wireless terminal to set up a connection for transmission of at least one multimedia component of a multimedia message addressed to said wireless terminal, characterized in that in the method it is examined whether said *notification message* contains a request to update the properties of the wireless terminal, wherein information on the properties of the wireless terminal is transmitted from the wireless terminal to the server in said connection set-up request [Salinas, notification request/response, col 10 lines 38-54; Forslow, col 17 lines 45-60]

19. As per claims 15,33,42 Salinas-Forslow disclose a WAP terminal is used as a wireless terminal and that a multimedia message service centre (MMSC) is used as a server [Forslow, the mobile switching center, col 11 lines 43-55].

20. As per claims 16,34,52 Salinas-Forslow disclose a connection set-up request is transmitted from the wireless terminal to set up a connection for the transmission of at least one multimedia component of a multimedia message addressed to said wireless terminal, characterized in that the connection set-up message used is a Uaprof information transmission message according to WAP specifications, and that the header

field is supplemented with a profile-diff header field, if the connection set-up message is supplemented with information on the properties of the wireless terminal, or the header field is supplemented with a profile header field if the connection set-up message is not supplemented with information on the properties of the wireless terminal [Forslow, packet header, col 16 line 66-coll 17 line 13; col 18 lines 22-38].

21. As per claim 17, Salinas-Forslow disclose those components of the multimedia message specified in the property information of the receiving wireless terminal stored in the multimedia messaging system are transmitted *without* a transmission request being transmitted from the wireless terminal [Salinas, dynamic assigned address to a mobile node, col 8 line 57-col 9 line 25].

22. As per claims 18,41 Salinas-Forslow disclose a transmission request is transmitted from the wireless terminal to transmit such multimedia message components which have *not* been specified in the property information of the receiving wireless terminal stored in the multimedia messaging system as a design choice of empty field [Salinas, col 11 lines 5-22].

23. As per claim 51, Salinas-Forslow disclose the wireless terminal is a WAP terminal or mobile node [Forslow, Fig 1].

24. As per claims 30,40 Salinas-Forslow disclose means (55) for examining the validity of said property information of the wireless terminal stored in the server, and means (55) for attaching a request to update the properties of the wireless terminal to said notification message [Salinas, col 10 lines 1-26].

25. As per claim 39 Salinas-Forslow disclose interface means (51, 52, 53) for receiving a multimedia message addressed to the wireless terminal, which multimedia message comprises at least one multimedia component, and means (18, 15, 12) for forming a *notification message* for transmission to the wireless terminal to indicate that a multimedia message has arrived, characterized in that the server also comprises means to examine whether information on the properties of the wireless terminal in question is stored in the server, control unit means (55) for attaching a request to *update* the properties of the wireless terminal to said notification message, and means (MPLI, RF, ANT) for receiving information on the properties of the wireless terminal at the server [Salinas, notification request/response, col 10 lines 38-54; update mobile subscriber information, col 3 lines 13-28].

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

*Thong Vu*  
*Patent Examiner*  
*Art Unit 2142*

